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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/583,372	05/31/2000	Yuhpyng L. Chen	U-014297-5	4427
7590 02/18/2004			EXAMINER	
Ladas & Parry 26 West 61st Street New York, NY 10023			JONES, DWAYNE C	
			ART UNIT	PAPER NUMBER
			1614	

DATE MAILED: 02/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/583,372

Applicant(s)

CHEN, YUHPYNG L.

Examiner

Dwayne C Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 5-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 10 is/are allowed.
- 6) ☐ Claim(s) 1,3,4 and 9 is/are rejected.
- 7) ☐ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. Claims 1-4, 9, and 10 are pending.
2. Claims 1, 3, 4, and 9 are rejected.
3. Claim 2 is objected.
4. Claim 10 is allowable.
5. Claims 5-8 are cancelled as per the amendment of July 17, 2003.

Response to Arguments

6. Applicant's arguments with respect to claims 1-4, 9, and 10 have been considered but are moot in view of the new ground(s) of rejection.

Election/Restrictions

7. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

8. In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

9. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

10. In addition, the following advisory is mentioned. Once product claims 1-4, 9, and 10 are found to be allowable, withdrawn and cancelled claims 5-8 are to be rejoined, pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86). Claims 5-8, directed to the process of making or using the patentable product, previously withdrawn from consideration as a result of a restriction requirement

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of September 27, 2001. In addition, it is further noted that In accordance with the Official Gazette notice, *supra*, process claims 5-8, must include all the limitations of the allowable product in order to be been rejoined. Accordingly, it is recommended that these non-elected claims are to be limited in scope with the instant compounds claims as well as definiteness, under 35 U.S.C. 112, second paragraph.

Claim Objections

11. Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 112

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons support this rejection. The variable of R_4 is defined as the group "CH₂OF₃", which is unclear and ambiguous, since the valency of oxygen would be exceeded. The variable of R_4 is defined as "cyano" twice, which causes indefiniteness to this claim.

14. Claims 3, 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The variable of R_4 is defined as "cyano" twice, which

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causes indefiniteness to this claim. The variable of R_4 is defined as the group " CH_2OF_3 ", which is unclear and ambiguous, since the valency of oxygen would be exceeded.

When the variables of R_1 and R_2 are C_1 - C_6 alkyl and C_1 - C_{12} alkyl, respectively, it is stated that these groups "may optionally independently contain from one to three double or triple bonds." However, the fact that an alkyl group can only possess single bonds, not double or triple bonds, presents ambiguity to the claims. In addition, the variable of "m" in the moiety of $\text{S}(\text{O})_m$ is not defined in the variables of R_1 and R_2 . These issues make the claims unclear and thus render the claims vague and indefinite.

15. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

16. Claim 9 recites the limitation "COOH" in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim. Claim 3 does not provide support for an electron deficient group of "COOH".

Allowable Subject Matter

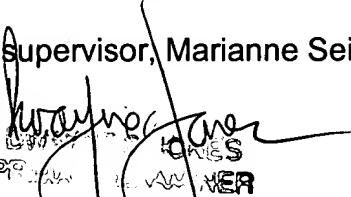
17. Claim 10 is free of the prior art of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. C. Jones whose telephone number is (571) 272-0578. The examiner can normally be reached on Mondays, Tuesdays, Thursday, and

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Fridays from 8:30 am to 6:00 pm. The official fax No. for correspondence is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel, may be reached at (571) 272-0584.


PP 2/16/04
VER

Tech. Ctr. 1614
February 16, 2004